REMARKS

This amendment follows the outstanding Official Action dated 03/12/03 and is intended as a complete and proper response thereto. In particular, the present paper is presented with the view of advancing prosecution of this application on its merits and hopefully placing this case in a clear condition for allowance.

In order to render this Amendment responsive, a Petition for Extension of Time to Respond Within the Second Month Pursuant to § 1.136(a) is submitted herewith in duplicate along with the requisite petition fee of $205.00 commensurate with the applicant's small entity status as previously established.

Claims 1-20 remain in the application. These remaining claims have been amended in accordance with the examiners detailed action. Reexamination and reconsideration of the application, as amended, is requested.

Claims 1 and 2 were initially objected to as having informalities. Appropriate amendments have been made to correct these informalities.

Claims 1 and 9 were rejected under 35 U.S.C. § 112 as being indefinite and once again, the appropriate corrections were made to the preamble of these claims to clearly set forth how the spread of disease from the cutting knife is prevented. As such, the examiners changes and suggestions have been made to overcome this rejection.

The examiner has also made a double patenting rejection based upon U.S. Patent 6,321,484 as well as an obviousness type double patenting rejection based upon the same patent. An appropriate terminal disclaimer has been included with this action and as such, it is believed that these double patenting rejections have been overcome as both this current application and the patent have always been and continue to be commonly owned and an appropriate disclaimer is included.

As initially presented claims 1-3, 9-12 and 14 have been rejected under 35 U.S.C. 102(b) as being clearly anticipated by the Maroney 5,528,967 patent. For prior art to anticipate under § 102, every element of the claimed invention must be identically disclosed, either expressly or under principles of inherencey, in a single reference. *Corning Glass Works v. Sumitomo Electric*, 9 U.S.P.Q. 2d 1962, 1965 (Fed. Cir.1989). The exclusion of a claimed element, no matter how insubstantial or obvious, from a prior art reference is enough to negate anticipation. *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

The Maroney 967 patent generally discloses a fluid jet fruit slicer wherein frozen cherries having pits are dropped into a trough and fed into a wheel with a U-shaped cavity. The U-shaped cavity of the wheel grabs the cherries and turns them through a water jet which slices the cherries into two hemispherical sections while leaving the pit intact, see generally column 3, lines 10 and 11. The examiner has argued that Maroney teaches sizing of cut grown agricultural products by a separator 138. The separator in Maroney is nothing more than a divider placed in the trough where the cherries are dumped so that half of the cherries go on one side and half on the other. This separator 138 in no way is a sizer as it is not able to differentiate in

any way between the shape of the cherries that are dumped onto the trough and merely directs half of the cherries one way and half the other way as is shown and clearly explained in the application.

Further, Maroney does not supply a chamber but rather holds the cherries in a U-shaped wheel. The examiner also points to 56 as being the stream collector tubes or discharge tubes. Number 56 in the Maroney patent is the actual jet itself and is thus not the discharge tube for collecting spent water. Thus, it is believed that this discussion of Maroney clearly shows that the current application is not anticipated by Maroney as currently claimed in the amended claims.

Claims 1-3, 9-12 and 14 have all been rejected under 35 U.S.C. § 103(a) as being unpatentable over Maroney in view of Miles et al. 3,096,801. For prior art references to be combined to render obvious a subsequent invention under § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q. 2d 1434, 1438(Fed. Cir. 1988). The teaching of the references can be combined only if there is some suggestion or incentive in the prior art to do so. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599(Fed. Cir. 1988). Hindsight is forbidden. It is impermissible to use the claims as a framework from which to pick and choose individual references to recreate the claimed invention. *Id.* at 1600; *W.L. Gore*, 220 U.S.P.Q. at 312. Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir.

1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

The Maroney 5,528,967 patent has been discussed above in detail. The Miles et al 801 patent generally discloses a seed potato cutter which sizes potatoes and then cuts them using a knife which is the standard method used today and presents all of the problems solved by the current application. The examiner has used this patent in combination with Maroney to show that it is known to sort seed potatoes and to cut them with a water jet. Once again, Maroney has been discussed in length and it is submitted that no where is there any teaching in these applications to combine a seed potato cutter as shown with a device for slicing cherries and leaving the pits in tact as discussed in Maroney. The combination of these two applications does not solve the problems presented nor does it teach what is currently claimed in the application. In particular, Maroney does not supply a chamber, does not size the potatoes, nor does it teach the use of a discharge tube.

Finally, the examiner has also used the Draper et al. 3,570,050 patent to show that it is obvious to make several cuts on a potato by comparing it to a chicken which is being deboned in the Draper et al. application. Once again, the water jets do not cut completely through the item being cut in Draper et al. but leave the bones intact and cut meat from the bones. These bones may then be tumbled under multiple jets to remove remaining meat pieces. This tumbling does not disclose the use of precision cutting in to multiple pieces, nor does it cut all the way through as in the current application. The Maroney device would have to be substantially modified to produce the claimed invention and would not be obvious in light of the Miles et al. and Draper et al. patents. Further, there is no teaching in any

of these patents to combine the applications as is currently done. Indeed, Miles et al. teaches the use of the common knives which transfer disease as is currently practiced in the art and which is the subject of the current application.

Thus, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to have used the Maroney device in combination with a chicken processing machine and a standard potato cutter to show the applicants current method as claimed. Indeed, the applicant's modifications go substantially beyond merely an alternate and rather is a non-obvious method for preventing the spread of disease and of cutting seed potatoes for planting.

In light of the foregoing discussion of the applied art of record, the presentation of the amended schedule of claims and the indication as to how such claims are considered to clearly and patentably define over the references, it is believed that the patentable nature of the claims has been demonstrated.

In view of the above remarks, reconsideration and allowance of the claims is kindly requested. Should any matters remain outstanding that may be handle over the phone the examiner is encouraged to call.

Respectfully Submitted,

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